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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,942	12/27/2000	Akira Haneda	2583-107	3483

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EXAMINER

NGUYEN, KIMBERLY T

ART UNIT	PAPER NUMBER
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1774

3

DATE MAILED: 03/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

WA-3

<b>Office Action Summary</b>	<b>Application No.</b> 09/747,942	<b>Applicant(s)</b> HANEDA ET AL.	
	<b>Examiner</b> Kimberly T. Nguyen	<b>Art Unit</b> 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 4 and 5** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 5 are unclear. In claims 4 and 5, Applicants show an ink print layer on *at least one side* of the base; however, Applicants also show that a first coating layer is formed on a *non-printed side* of said base. Does this mean that when there are two ink print layers, there is no first coating layer?

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al., U.S. Pat. No. 6,165,592.

Berger shows a security document comprising a paper carrier (base) and a security attribute affixed to the carrier comprising an adhesive layer containing fluorescent ink (column 6, lines 40-53), and a reflective metal layer (outer layer) (column 6, lines 8-25).

Berger does not show that the security attribute is duplicated on the other side of the paper carrier as in instant claims 1 and 4. However, it is obvious to provide the security attribute on *both* sides of the carrier, motivated by the desire of providing the desired security reading properties to both sides (i.e., to enable the reading of both sides of the carrier) absent any evidence to the contrary.

Berger does not show the percentage of opacity of the reflective metal layers as in instant claims 1, 2, and 4. However, a metal layer is substantially opaque and the percentage of opacity is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the percentage of opacity, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operating conditions (e.g. percentage of opacity) fails to render claims patentable in the absence of unexpected results.

**Claims 3 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al., 6,165,592 in view of Katagiri, U.S. Pat. No. 6,074,739.

Berger shows a security document comprising a paper carrier (base) and a security attribute affixed to the carrier comprising an adhesive layer containing fluorescent ink (column 6, lines 40-53), and a reflective metal layer (outer layer) (column 6, lines 8-25).

Berger does not show that the security attribute is duplicated on the other side of the paper carrier as in instant claims 1 and 4. However, it is obvious to provide the security attribute on *both* sides of the carrier, motivated by the desire of providing the desired security reading

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properties to both sides (i.e., to enable the reading of both sides of the carrier) absent any evidence to the contrary.

Berger does not show the percentage of opacity of the reflective metal layers as in instant claims 3 and 5. However, a metal layer is substantially opaque and the percentage of opacity is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the percentage of opacity, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operating conditions (e.g. percentage of opacity) fails to render claims patentable in the absence of unexpected results.

Berger does not show that the metal layer can also be made of paper as in instant claims 3 and 5. However, the opaque metal layer and paper are functional equivalents. Katagiri shows a fluorescent composite wherein a substrate layer is substantially opaque and may be composed of paper *or* metal. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an opaque layer of metal or paper having the opacities of the instant invention since they are known to be functional equivalents.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9310 for before final communications and (703) 872-9311 for after final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly Nguyen  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

A handwritten signature in black ink, appearing to read 'Cynthia H. Kelly', written in a cursive style.